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EXAMINER

BERMAN, ALYSIA

ART UNIT

PAPER NUMBER

1617

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/441,832

Applicant(s)

LAWSON ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 26, 2002 has been entered.

Claims 1, 7, 8, 15, 16 and 21 have been amended. Claims 1-26 are pending.

***Election/Restrictions***

In view of the amended claims requiring both a sterol-based and a carbohydrate-based surfactant/emulsifier all claims have been examined as they relate to a composition comprising either a sterol-based surfactant/emulsifier or a combination of a sterol-based surfactant/emulsifier and a carbohydrate-based surfactant/emulsifier.

Claims 4-6, 20 and 22 are interpreted as requiring a carbohydrate-based surfactant/emulsifier in addition to the sterol-based surfactant/emulsifier of claim 1. Any new or amended claims directed to only a carbohydrate-based surfactant/emulsifier will be withdrawn as directed to a non-elected species of the invention as discussed in the Office Action mailed August 21, 2001, paper no. 7.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

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Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because claims 1, 15 and 16 recite the term derivatives but do not provide a definition of what is encompassed by this term. It is unclear what Applicant intends to encompass by derivatives of cholesterol and phytosterols. Neither the specification nor the claims provides an exclusive definition of the specific derivatives. The metes and bounds of the claims cannot be determined.

Claims 4, 7 and 24 are indefinite because they require that the surfactant/emulsifier be carbohydrate-based but depend from claims that recite only sterol-based surfactant/emulsifier.

Claims 4, 7 and 24 are indefinite because the term "carbohydrate-based" is unclear. It is unclear what Applicant intends to encompass by surfactant/emulsifiers based on carbohydrates. Neither the claims nor the specification provides an exclusive definition of the substances encompassed by this term. The metes and bounds cannot be determined.

Claims 5 and 20 are indefinite because the terms sucrose-based and glucose-based are unclear. It is unclear what Applicant intends to encompass by surfactant/emulsifiers based on sucrose and glucose. Neither the claims nor the specification provides an exclusive definition of the substances encompassed by this term. The metes and bounds cannot be determined.

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Claims 8 and 21 are indefinite because they are written in improper Markush group form. It is unclear which surfactant/emulsifiers Applicant intends to be part of the Markush group and which are to be used in place of PPG-20 methyl glucose ether. Amendment of the claims deleting the phrase "in place of PPG-20 methyl glucose ether" would overcome this rejection.

Claims 8 and 21 are indefinite because they appear to be directed toward a Markush group of what Applicant calls carbohydrate-based surfactant/emulsifiers but recite glycerol monostearate as one species of surfactant/emulsifier. Glycerol monostearate is not a carbohydrate by definition.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-4, 6-11, 14-18, 21-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US 5,567,420 (420).

US '420 discloses a colored cosmetic composition in the form of a gel (abstract and claims 1 and 9). For polyhydric alcohols and water, see column 3, lines 38-40, column 5, line 58, Table 1 at column 9, and claim 9. For pigments such as titanium dioxide, talc and kaolin in an amount from about 2-25 wt.% and 1-10 wt.%, respectively, see column 5, lines 1-8 and claim 10. For sterols, see column 5, line 61. For fatty acid alkali metal salts and ethoxylated cholesterol as emulsifiers, see column 6, lines 25-54. For cholesterol, see column 8, line 4. For glycerol monostearate, one of Applicant's preferred "carbohydrate-based" surfactant/emulsifiers see column 6, lines 51-52.

US '420 does not teach the amounts of components as instantly claimed in claims 15 and 16 and does not explicitly teach alkali metal salts of behenic acid. It is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). Therefore, absent evidence of unexpected results, the amounts of components are not given patentable weight over the prior art. US '420 teaches alkali metal salts of fatty acids (fatty acid soaps) at column 6, lines 30-32. The disclosed alkali metal salts of fatty acids differ from the instantly claimed alkali metal salts of behenic acid, such as sodium behenate, as adjacent lower homologs. The claimed invention would have been obvious to the skilled artisan because close structural similarity of the reference compound suggests the claimed compound. One skilled in the art would expect the two compounds to have similar properties.

The intended use of a substance in a composition does not render the instantly claimed composition patentable over the prior art composition containing that substance for a different use. See *In re Tuominen*, 213 USPQ 89, *In re Spada* 15 USPQ 1655, MPEP §2112.01 and *In re Pearson*, 181 USPQ 641. A substance contained in a composition containing the same components as instantly claimed would be expected to exhibit the same properties absent evidence to the contrary. Therefore, no criticality is given to the limitation that the sterol-based component is a surfactant/emulsifier.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '420 selecting optimal components and amounts of components with the expectation of obtaining a composition that provides moisturizing benefits to the skin.

Claims 1, 2, 4, 6-11, 14-17, 21-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US 5,747,049 (049).

US '049 discloses a cosmetic composition comprising titanium dioxide, talc, kaolin and zinc oxide (col. 5, lines 41-43). For additional pigments, see column 10, line 58 to column 11, line 17. For polyhydric alcohols, see column 6, lines 22-28. For cholesterol derivatives and phytosterols, see column 6, lines 48-51, column 8, lines 6, 19-20 and 26. For fatty acid alkali metal salts, see column 8, lines 49-50. For glycerol monostearate, one of Applicant's preferred "carbohydrate-based" surfactant/emulsifiers see column 9, line 35 and Formulation Example 4 at column 16.

US '049 does not teach the amounts of components as instantly claimed in claims 15 and 16. It is within the skill in the art to select optimal parameters, such as

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amounts of ingredients, in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). Therefore, absent evidence of unexpected results, the amounts of components are not given patentable weight over the prior art.

The intended use of a substance in a composition does not render the instantly claimed composition patentable over the prior art composition containing that substance for a different use. See *In re Tuominen*, 213 USPQ 89, *In re Spada* 15 USPQ 1655, MPEP §2112.01 and *In re Pearson*, 181 USPQ 641. A substance contained in a composition containing the same components as instantly claimed would be expected to exhibit the same properties absent evidence to the contrary. Therefore, no criticality is given to the limitation that the sterol-based component is a surfactant/emulsifier.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of either US '420 or US '049 and select optimal amounts of components with the expectation of obtaining a composition that provides moisturizing benefits to the skin.

Claims 5, 12, 13, 19, 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US '049 each as applied to claims 1-4, 6-11, 14-18, 21-23 and 25 above, and further in view of US 5,741,499 (499).

US '420 and US '049 teach all the limitations of the claims as stated above. They do not teach isoprene glycol or pigment coated with dimethicone. US '499 teaches topical mousse compositions that comprise isoprene glycol (col. 7, line 2) and pigments that may be coated with silicone compounds (col. 8, line 66 to col. 9, line 15). The compositions may also contain hydrophilic additives such as glucose and sucrose (col.



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8, lines 36-42). The intended purpose of a component in a composition does not render the composition containing that component patentable over a prior art composition containing that component for a different purpose.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of either US '420 or US '049 substituting isoprene glycol and silicone coated pigments as taught by US '499 with the expectation of providing a composition with moisturizing benefits and good color.

Claims 12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US '049 as applied to claims 1-4, 6-11, 14-18, 21-23 and 25 above, and further in view of US 5,393,526 (526).

US '420 and US '049 teach all the limitations of the claims as stated above. They do not teach dimethicone-coated pigments. US '526 teaches that colored cosmetic compositions generally require pigments of which dimethicone coated titanium dioxide is preferred (col. 2, lines 53-64).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of either US '420 or US '049 substituting dimethicone coated pigments as taught by US '526 with the expectation of providing a cosmetic composition with good color.

Claims 4-6 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US '420 or US '049 as applied to claims 1-4, 6-11, 14-18, 21-23 and 25 above, and further in view of US 5,002,680 (680).

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US '420 teaches all the limitations of the claims as stated in the 35 U.S.C. 103(a) rejections above. It does not teach sucrose or glucose based surfactant/emulsifiers.

US '680 is directed to mousse skin care compositions (title). The compositions can contain methyl glucoside, sucrose distearate and sucrose laurate as emulsifiers to improve the stability of the composition.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the sugar ester emulsifiers of US '680 to the composition of US '420 or US '049 for their emulsifying properties.

### ***Response to Arguments***

Applicant's arguments filed September 26, 2002 have been fully considered but they are not persuasive.

Applicant argues that US '420 makes no mention of non-emulsion, mousse-textured compositions containing alkali salts of fatty acid esters. US '420 discloses or suggests all the components of the instant claims as stated in the 35 U.S.C. 103(a) rejections above. Although US '420 may not explicitly disclose one composition containing all of the components instantly claimed, the reference does disclose that all of the components instantly claimed can be used in the compositions. One of ordinary skill in the art would be motivated to use any combination of the prior art disclosed components in order to achieve the desired result. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

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The idea of combining them flows logically from their having been individually taught in the prior art. *In re Crockett*, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (CCPA 1960).

The CTFA documents supplied by Applicant have been reviewed. Applicant's argument that the only way previously known of making mousse-textured compositions was that disclosed by the CTFA documents is not convincing. A mousse is a foam composition and is not defined as set forth in the CTFA documents. The CTFA documents set forth a sub-species of mousse compositions but do not limit the broad genus of mousse compositions as set forth in the claims. Therefore, absent evidence of unexpected results obtained by the particular combination of components instantly claimed, the instant claims are obvious over the prior art.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
RUSSELL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200